

REMARKS

Claims 1–22 and 40 are pending in the present application. Claims 7–9 and 13–15 are withdrawn. Claims 1, 16 and 40 are in independent form. Claims 2–6 and 10–12, and 17–22 depend from independent claims 1 and 16, respectively. In the aforementioned *Office Action*, claims 1–6, 10–12, 16–22 and 40 were examined and rejected. In view of the following amendment and remarks, Applicant respectfully requests reconsideration of the application.

Response to Election of Species

The *Office Action* states that “an election (to a species) was made without traverse in the reply filed on 3/29/06.” *Office Action*, 2, line 7. In response to this statement, Applicant contends that an election was made with traverse. Referring to Response A, page 9, ¶ 2–3, stating, “[a]pplicant elects, with traverse, to proceed with the second species, directed to the embodiment in at least claims 10–12. Claims 7–9 and 13–15 are presently being withdrawn.” “Applicant believes claim 1 to be a generic claim from which all three species read upon. As such, Applicant is traversing the species restriction.”

Please reconsider the election with traverse requested in Response A.

Rejections under 35 U.S.C. § 101

On page 2, the Examiner rejected claims 1–6, 10–12 and 16–22 under 35 U.S.C. § 101, “because the claimed invention is directed to non-statutory subject matter. The claims, as presented, do not restrict the inventive concept to a tangible embodiment.” *Office Action*, 2, lines 16–18. Applicant respectfully traverse the

Examiner's 35 U.S.C. § 101 rejection in that the invention is directed to statutory subject matter.

35 U.S.C. 101 requires that a claimed invention, as a whole, be useful and accomplish a practical application; that is, it must produce a "useful, concrete and tangible result." State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368, 1373–74 (Fed. Cir. 1998). The purpose of this requirement is to limit patent protection to inventions that possess a certain level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research. *See In re Fisher*, 421 F.3d 1365 (Fed. Cir. 2005).

Applicant contends the independent claims all possess a certain level of 'real world' value in that they all teach a 'useful, concrete and tangible result,' because they all have some means to prevent usage of a secured file. For example, claim 1 provides "preventing subsequent usage of the designated content in a destination application via the clipboard application when said determining determines that the source file is a secured file." The other independent claim, claim 16, recites, "preventing storage of the designated content to the clipboard application when said determining determines that the source file is a secured file."

Applicant contends that claim 1 and claim 16 each have a useful, concrete and tangible result, because each restricts the usage or storage of a secured file. The application contains examples of embodiments of these method claims.

Rejections under 35 U.S.C. § 102(e) per Medoff

The Examiner rejected claims 1–6, 10–12, 16–22 and 40 "under 35 U.S.C. § 102(e) as being anticipated by Medoff, [hereinafter *Medoff*], Pub. No. US 2003/0088517." *Office Action*, 2, line 32. The 'every element test' states that "A claim

is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicant respectfully traverses the Examiner’s 35 U.S.C. § 102(e) rejection, because *Medoff* does not contain each and every element in claims 1–6, 10–12, 16–22 and 40.

Claim 1 recites, in part, “determining whether the source file is a secured file.” The Examiner contends that this element is taught by *Medoff* [0082]–[0087]. Specifically, *Medoff* discloses,

At step 326, the server sends additional commands to the client browser to limit copying and printing of the pages. One of the commands instructs the browser to disable the key functions of external input devices attached to the computer. The external input devices are any devices being able to input a command to the computer to print or copy and paste, such as the keyboard and mouse. The key functions include printing, copying and pasting using the keys on the keyboard. The key functions also include highlighting, copying and pasting, and pulling down a submenu having a print option using the mouse. Other input functions to view the pages, such as navigation button and vertical scroll bars, are not disabled. [0082].

While *Medoff* discloses methods to prevent copying and printing of web pages, *Medoff* discloses a method to send ‘server commands’ to disable the key functions of external input devices attached to the computer. The server commands are sent together with the web pages to be secured. As such, determining whether a web page should be secured or not is performed prior to a user accessing the web page. Thus *Medoff* does not teach determining whether the source file is a secured file as is claimed in claim 1.

As each and every claim element of claim 1 is not taught by *Medoff*, claim 1 is not anticipated by *Medoff*. See Verdegaal Bros. Claims 16 and 40 have similar

“determining whether the source file is a secured file” element and are not anticipated for at least the same reasons as claim 1. Claims 2–6 and 10–12, and 17–22 depend from independent claims 1 and 16, respectively. As such these claims are not anticipated for at least the same reasons as claim 1 discussed above. *See* 35 U.S.C. § 112, para. 4.

As claims 1–6, 10–12, 16–22 and 40 are not anticipated by *Medoff*, Applicant respectfully requests the Examiner withdraw the 35 U.S.C. § 102(e) rejection of claims 1–6, 10–12, 16–22 and 40.

Rejections under 35 U.S.C. § 102(b) per Mast

The Examiner rejected claims 1–6, 10–12, 16–22 and 40 under 35 U.S.C. § 102(b) as being anticipated by *Mast*, [hereinafter *Mast*], Patent Number: 5,881,287. *Office Action*, 4, lines 12–13. Applicant respectfully traverses the Examiner’s 35 U.S.C. § 102(b) rejection, because *Mast* does not contain each and every element in claims 1–6, 10–12, 16–22 and 40.

Claim 1 recites, in part, “preventing subsequent usage of the designated content in a destination application via the clipboard application when said determining determines that the source file is a secured file.” The Examiner contends that this element is taught by *Mast* [Col. 8, lines 18–34; Col. 9, lines 22–67]. Specifically, *Mast* discloses,

[T]he Developer makes minor source code modifications to an enabled application and link edits the application along with BITBLOCK.DLL. BITBLOCK.CLL prevents the Developer’s protected images from being copied to any destination (e.g. global memory, the Windows clipboard, etc.) by any application other than the Developer’s product, including Windows itself. [Col. 8, lines 26–34].

Although *Mast* teaches methods to prevent copying images, *Mast* discloses a method to protect images from being copied to any destination using BITBLOCK.DLL, even to Windows clipboard. This teaching is contrary to preventing subsequent usage of the designated content in a destination application via the clipboard application, because BITBLOCK.DLL prevents the image from any copying to the clipboard. Thus, in *Mast*, 'a clipboard application' does not prevent any subsequent usage as is claimed in claim 1.

Additionally, Claim 1 recites, in part, "determining whether a source file is a secured file." The Examiner contends that this element is taught by *Mast* [Col. 8, lines 18–34; Col. 9, lines 22–67]. In exemplary embodiments, a 'secured file' is a file or document has data that cannot be accessed without *a priori* knowledge. One example of the *a priori* knowledge is a password. Another example of the *a priori* knowledge is a file key available only to an authenticated user. [Application, 0017]. *Mast* does not teach determining whether a source file is a secured file, for the files are assigned with 'hooks' prior to distribution.

As each and every claim element of claim 1 is not taught by *Mast*, claim 1 is not anticipated by *Mast*. See Verdegaal Bros. Claim 40 has a similar 'clipboard application' element and is not anticipated for at least the same reasons as claim 1. Claims 2–6 depend from independent claim 1. As such these claims are not anticipated for at least the same reasons as claim 1 discussed above. See 35 U.S.C. § 112, para. 4.

Additionally, claim 1 recites, in part, "receiving a copy selection associated with designated content of a source file being displayed by a source application." *Mast* does not teach that the source file is being displayed by a source application. Instead, this portion of *Mast* only describes using BITBLOCK.CLL to prevent the Developer's protected images from being copied to any destination (e.g. global

memory, the Windows clipboard, etc.) by any application other than the Developer's product, including Windows itself. [Col. 8, lines 26–34].

As each and every claim element of claim 1 is not taught by *Mast*, claim 1 is not anticipated by *Mast*. Claims 16 and 40 have similar elements and are not anticipated for at least the same reasons as claim 1. Claims 2–6 and 10–12, and 17–22 depend from independent claims 1 and 16, respectively. As such these claims are not anticipated for at least the same reasons as claim 1 discussed above. *See* 35 U.S.C. § 112, para. 4.

As claims 1–6, 10–12, 16–22 and 40 are not anticipated by *Mast*, Applicant respectfully requests the Examiner withdraw the 35 U.S.C. § 102(b) rejection of claims 1–6, 10–12, 16–22 and 40.

Rejections under 35 U.S.C. § 102(a) per SecurityOptions

The Examiner rejected claims 1–6, 10–12, 16–22 and 40 under 35 U.S.C. § 102(a) as being anticipated by *SecurityOptions*, [hereinafter *SecurityOptions*]. *Office Action*, 5, lines 23–24. Applicant respectfully traverses the Examiner's 35 U.S.C. § 102(a) rejection, because *SecurityOptions* does not contain each and every element in claims 1–6, 10–12, 16–22 and 40.

Claim 1 recites, in part, "determining whether the source file is a secured file." The Examiner contends that this element is taught by *SecurityOptions* [Pages 1–2]. Specifically, *SecurityOptions* discloses,

The *SecurityOptions* element specifies settings for securing the content of a document. iSiloX and iSiloXC add indicators to the converted document so that conforming applications that utilize the document can determine what types of actions to allow on the document. [Page 1].

Although *SecurityOptions* teaches methods to prevent copying documents, *SecurityOptions* discloses a method to protect documents when conforming applications utilize the documents. The documents are associated with elements to specify the allowed functions. These elements are specific to the allowed functions, e.g., CopyAndPaste “specifies that copying to the clipboard should be allowed.” This is contrary to determining whether the source file is a secured file as is claimed in claim 1.

Additionally, Claim 1 recites, in part, “determining whether a source file is a secured file.” The Examiner contends that this element is taught by *SecurityOptions* [Pages 1–2]. In exemplary embodiments, a ‘secured file’ is a file or document has data that cannot be accessed without *a priori* knowledge. One example of the *a priori* knowledge is a password. Another example of the *a priori* knowledge is a file key available only to an authenticated user. [Application, 0017]. *SecurityOptions* does not teach determining whether a source file is a secured file, for the files are assigned indicating elements prior to distribution.

As each and every claim element of claim 1 is not taught by *SecurityOptions*, claim 1 is not anticipated by *SecurityOptions*. Claims 16 and 40 have similar ‘determining whether the source file is a secured file’ and ‘determining a secured file’ elements and are not anticipated for at least the same reasons as claim 1. Claims 2–6 and 10–12, and 17–22 depend from independent claims 1 and 16, respectively. As such these claims are not anticipated for at least the same reasons as claim 1 discussed above. *See* 35 U.S.C. § 112, para. 4.

As claims 1–6, 10–12, 16–22 and 40 are not anticipated by *SecurityOptions*, Applicant respectfully requests the Examiner withdraw the 35 U.S.C. § 102(a) rejection of claims 1–6, 10–12, 16–22 and 40.

Conclusion

Based on the above remarks, Applicant believes that the rejections in *the Office Action* are fully overcome, and that the application is in condition for allowance.

Applicant respectfully requests the passage of the present application to issue. If the Examiner has any questions regarding the present application or other issues that might be expedited through a telephone conference rather than a written action, the Examiner is invited to contact the Applicant's undersigned representative at the number provided below.

Respectfully submitted,

Patrick Zuili

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By: Michael P. Wiersch
Michael P. Wiersch, Reg. No. 55,996
Carr & Ferrell LLP
2200 Geng Road
Palo Alto, CA 94303
Phone: (650) 812-3400
Fax: (650) 812-3444